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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,268	02/02/2002	Norbert Klein	(E) 1757 US	4430

7590 07/12/2005

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EXAMINER
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ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,268

Applicant(s)

KLEIN, NORBERT

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/1/03 (election of Group I).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050309.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **FIRST OFFICE ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I (claims 1-19) in the reply filed on June 1, 2003 is acknowledged. Claims 20 and 21 have been withdrawn from further consideration as being drawn to a nonelected invention.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on February 2, 2001. No certified copy of the German application as required by 35 U.S.C. 119(b) has been found in the application file. No certified translation of the German priority document has been received to establish applicant's priority date over applied prior art.

### ***Drawings***

3. There are no objections to the drawings filed February 2, 2002.

### ***Information Disclosure Statement***

4. The "INFORMATION DISCLOSURE CITATION" received March 9, 2005 has been considered. An initialed form PTO-1449 is enclosed with this First Office Action.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1-19 are indefinite since they recite a sheet blank "for an exhaust gas housing part of a motor vehicle" (e.g. claim 1, line 1) but also require that two assembled blanks "locally reinforce a finished exhaust gas housing part" (e.g. claim 1, line 3). It appears that the pending claims not only cover the article as a blank (i.e. before being made into the finished article), but also have been drafted cover the article as part of the finished product. Clarification of the claim language is requested.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,892,852. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reinforced sheet blank for an exhaust gas housing part of the pending claims and the reinforced sheet blank as an exhaust housing part for an exhaust muffler of the patent's claims are not patentably distinct inventions. Both sets of claims contain the inventive concept of locally reinforcing a sheet blank for an exhaust gas housing part by having regions of greater thickness before subjecting the sheet blank to a stamping process.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwood (EP Application 0324891) in view of Hillman (U.S. Patent 6,048,628), Frings (U.S. Patent

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4,902,872), Ebert (DE 4307563), Fields (U.S. Patent 6,204,469) and Matsuuchi (U.S. Patent Application Publication 2001/0025408).

12. Harwood shows that exhaust gas housing parts for motor vehicles are conventionally stamp formed from sheets of metal in the prior art (e.g. see Figure 1; columns 1-4). Harwood differs from the claims mainly in that Harwood does not show locally reinforced (i.e. thicker) sections in the metal sheets used for the exhaust gas housing parts. Hillman, however, discloses that it is "conventional practice to design a plate-structure part intended for a part-shaping operation with a thickness which varies in zones according to the mechanical loads to which the zones of the resulting part will be subjected". Hillman discloses that such sheet blanks are formed by welding thicker sheets to thinner sheets and also by welding a sheet over another to form a reinforced regions (e.g. column 1, line 10 - column 2, line 5). Hillman discloses that these blanks are used for stamped parts in the automotive industry. Frings is applied to show that it is well understood in the automotive industry that "shaped sheet metal parts are as a rule subjected to differential loading in individual zones and therefore regions of different thicknesses are conventionally used in the sheet metal blanks" (e.g. see column 1, lines 13-48). Ebert is also applied to disclose that vehicle parts can be reinforced by welding local reinforcing portions to the sheet metal before stamping (e.g. see Figures 1-2). Fields also discloses that automotive parts are conventionally made with sheet blanks where reinforcing pads or stiffeners are welded to the sheets before shaping (e.g. column 1, lines 14-61). Matsuuchi is applied simply to confirm that it is known in the art to use reinforcing plates in mufflers used in motor vehicles (e.g. Figures 1 and 2 - reinforcing plate 19; paragraph [0015]). It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to use reinforcing portions in the sheet blanks of the stamp formed exhaust gas housing parts of Harwood because Hillman, Frings, Ebert, Fields and Matsuuchi disclose that stamp formed parts have zones of greater mechanical loads and that material savings can be made by locally reinforcing the sheet blanks specifically in those zones. Regarding claims to specific regions of reinforcement for the exhaust gas housing blank, it is within the purview of one of ordinary skill in the art to determine the locations where an exhaust gas housing part would be subjected to greater mechanical loads. Mere observation of local regions of failure of an exhaust gas housing part during actual use would indicate those locations in need of local reinforcement. Regarding claims to specific reinforcement blank configurations, it would be within the purview of one of ordinary skill in the art to tailor the blank reinforcement configurations of an exhaust gas housing part to be present in only those regions subjected to greater mechanical loads.

### ***Conclusion***

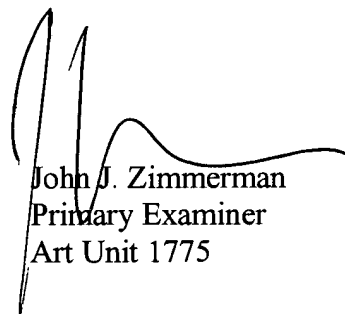
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited references serve to further establish the level of ordinary skill in the art at the time the invention was made.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can

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be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
July 7, 2005